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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/851,849 | 05/09/2001 | Bruce R. David | 10420/12 | 3674 |

757 7590 11/27/2006

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

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| ART UNIT | PAPER NUMBER |
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DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|----------------------------------------------------------------------|--------------------------------------|-------------------------------------|--|
| Notification of Non-Compliant Appeal Brief (37 CFR 41.37) | Application No. 09/851,849 | Applicant(s) DAVID ET AL. | |
| | Examiner Erica E. Cadugan | Art Unit 3722 | |


--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 1/27/2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

An attached explanation in support of the above item.


 Erica E. Cadugan
 Primary Examiner
 Art Unit: 3722

Attachment to Notice of Non-Compliant Appeal Brief

Basis for the Notice

1. 37 CFR 41.37(c)(1)(v) states the following:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) Summary of claimed subject matter . A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

2. Specifically, note the provision that sets forth that the brief must contain a “concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters”.

3. It is noted that the Board of Patent Appeals and Interferences remanded the case on November 3, 2006 such that this issue could be corrected.

4. Note that the basis for each and every limitation in each and every independent claim must be provided (via page and line number and/or drawing reference characters). In the instant case, a few examples of instances where the basis for limitations was not provided in the Summary of Claimed Subject Matter filed January 27, 2006 will be described. These examples are not meant to provide an all-inclusive list of such occurrences, but are meant to provide guidance to Applicant. Further review of the Summary of Claimed Subject Matter with respect to the independent claims to correct any and all such occurrences is required.

For example, the limitation about the fasteners “being drilled through the skin” in independent claim 1, the limitation about the fasteners being “drilled through the sheet metal” in independent claim 12, the limitation about the fasteners being “drilled through the skin” in claim 22; the limitation about the vertical adjustment being “within one-thousandth of an inch” in independent claim 22, etc., are a few such occurrences wherein the basis in the original specification was not described in the Summary of Claimed Subject Matter filed January 27, 2006.

Examiner suggests using a format like that used by the Examiner in the Examiner’s Answer mailed April 14, 2006, on pages 2-3 thereof, wherein Examiner mapped the independent claim 12 to the originally-filed specification in a way that is easy to quickly determine wherein support for each claim limitation lies.

Details on How to Correct the Non-Compliant Brief

5. NOTE that, as set forth in MPEP section 1205.02, in response to the Notice of Non-Compliant Appeal Brief under 37 CFR 41.37, when the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter in the manner as required by 37 CFR 41.37(c)(1)(v), **an entire new brief** need not, **and should not, be filed**. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See also MPEP sections 1215.04 and 711.02(b).

The paper that is filed providing **only** a proper summary of the claimed subject matter should make it clear that this is a replacement section of the Summary of the Claimed Subject Matter as required in response to this Notice of Non-Compliant Appeal Brief.

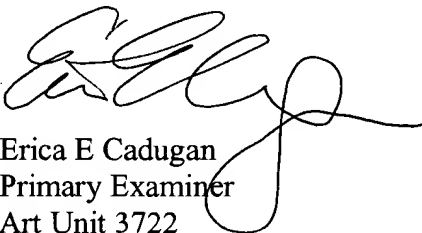
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474.

The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Erica E Cadugan
Primary Examiner
Art Unit 3722

eec

November 20, 2006